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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/758,820

01/11/2001

Swarupanda Ghosh

P/2167-232

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05/20/2005

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,820

Applicant(s)

GHOSH ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-37, and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-37 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 18, 2005, wherein:

Claims 1-4, 6-37, and 39 are currently pending;

Claims 5, 38 and 40-41 have been cancelled;

Claims 1, 6-7, 12, 16-20, 27, 32-34, 37, and 39 have been amended.

Claim Objections

2. Claims 32 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A dependent claim that is in a different statutory class than its independent claim is not automatically improper. To test if any claim is a proper dependent claim, use the "infringement test" in MPEP 608.01(n), Section III. If a claim is a **proper dependent** claim, it **cannot conceivably be infringed by anything that would not also infringe the claim it references**, i.e, if you can infringe the dependent claim without infringing the independent claim, then the dependent claim is an improper dependent claim because it does not require all the limitations of the independent claim.

Applying the infringement test, what is needed to infringe claim 33 is, for example, a processor having computer executable code that if and when executed would cause a computer to do the supplying, receiving, providing, updating and searching steps. However, such a processor would **not** infringe the method steps of

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claim 18 since the processor itself never performs any of the active steps of supplying, receiving, providing, updating and searching required by the method. In other words, mere possession of such a process would infringe claim 33, but this is not enough to infringe claim 18. As a result, claim 33 is an improper dependent claim.

This same analysis is applied to Claim 32.

Applying the infringement test, what is needed to infringe claim 32 is, for example, a CD-ROM having computer executable code that if and when executed would cause a computer to do the supplying, receiving, providing, updating and searching steps. However, such a CD-ROM would **not** infringe the method steps of claim 18 since the CD-ROM itself never performs any of the active steps of supplying, receiving, providing, updating and searching required by the method. In other words, mere possession of such a CD-ROM would infringe claim 32, but this is not enough to infringe claim 18. As a result, claim 32 is an improper dependent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4, 6-37, and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in

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the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant identifies an appointment database and appointment information. The applicant has not identified the term "appointment" in the specification. The applicant states that appointment information includes different types of insurance carriers, appointment request dates, effective appointment dates, products authorized for sale by the carrier through the agent, termination date and so forth (page 10, lines 12-19). What is an appointment? It is unclear what the term "appointment" actually encompasses. The applicant has not defined appointment request dates, effective appointment dates. What does the term product define? Why is this information necessary or how is it related to licensing information and compliance of licensing information.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 6-37, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what an appointment database or appointment information is. What does this term define? What are the products offered? Furthermore, it is unclear how this information would related to licensing information and determining compliance.

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Claim 10 is directed to a system. However, the applicant has the system comprising a notification.

In Claim 35, it is unclear what the applicant is claiming. The determination is made in claim 34. Is only one comparison necessary? It would appear that each licensee status and requirements would need to be compared.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 6-17, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lederer et al (US 2002/0023109) (hereinafter referred to as Lederer) in view of Hollingsworth (US 6,157,808).

Regarding Claims 1-4, 6-8 10-12, 16 and 37:

Lederer discloses a system (for facilitating regulatory compliance):

a plurality of databases ([0042 data storage], Figure 2 (data storage (122));

a processor coupled to the databases (page 3 [[0041] Global Regulatory Compliance System (GRCS) processing functionality 120 for performing its ascribed compliance related tasks) that provides notification ([0055]), with access to the one or

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more databases limited to authorized users ([0048] user is individual that is authorized to gain access to the system); .

Lederer does not disclose that the databases are adapted to contain a source of licensing requirement information, a source appointments information, or licensee information. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). While features of an apparatus may be recited structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. The system of Lederer is fully capable of storing the type information as set forth in applicant's claim.

Terms such as "operable to input data" or operable to locate portions" or "connectable" are not a positive recitation. The system of Lederer has a processor that is capable of inputting data, locating portions, and is connected to a network.

Lederer does not disclose that the system is for managing licensing information.

However, Hollingsworth discloses licensing information (Figure 3, (470, 472) Federal license/ license, col. 3, lines 33-40)

It would have been obvious to one of ordinary skill at the time of the invention to combine the licensing teachings of Hollingsworth with the disclosure of Lederer so as to provide a compliance means for evaluating the compliance information as it relates to an employee and to provide assurance that an employee possess the necessary

certifications and licenses to perform a particular task or duty and the employee is in compliance with all applicable statutes and regulations.

Regarding Claim 9:

Lederer discloses a processor operable to compare information with requirements and indicate differences [0054-0055] GRCS can successfully process information, access information in data storage to make a determination, access compliance information in data storage to determine the regulations in place, summarize its analysis).

Regarding Claims 13 and 14:

Lederer discloses a processor connectable to a worldwide network with access capabilities (system wide network 150 [0040], [0082] web server, [0050 interface 114 is coupled to the processing functionality 116 via any type of local-area or wide area network).

Regarding Claim 15 and 39:

Lederer discloses a communication interface (Figure 1 (114) input/output interface), said communication interface capable of accessing at least one licensing authority (page 3 [0045] the regulation source system 112 may comprise a governmental or other administrative agency or a commercially available database that

stores information regarding regulations promulgated by such governmental or administrative agency).

Regarding Claim 17:

Lederer discloses a computer display ([0106] a main screen area (1106) displays (Figure 11).

6. Claims 18-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollingsworth (US 6,157,808) in view of (National Regulatory Services) (hereinafter referred to NRS).

Regarding Claim 18 and 32-33,

Hollingsworth discloses a method and medium containing code for managing licensing information comprising:

obtaining requirements information from a plurality of authorities relating to obtaining and maintaining a license (col. 2, lines 43-45; Figure 3 (472/470 Federal License/License, col. 3, lines 33-40, col. 12, lines 51-56);

accessing a database coupled to at least one processor comprising entity information (col. 5, line 66 thru col. 6, line 33, col. 2, line 43 thru col. 3, line 6, abstract the system is able to establish an association between certifications and employees responsibilities);

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comparing the requirements to the entity information to produce a comparison (Figure 16 Compliance certification, col. 2, lines 56-58 the training module also includes a compliance means for evaluating the compliance information as it relates to each employee, col. 3, lines 25-40);

determining to what extent there is compliance (col. 3, lines 25-40 the invention identifies and reports for each employee job/task that the employee is in compliance with all applicable statutes and regulations), col. 4, lines 5-9, col. 15, lines 19-23);

Hollingsworth does not disclose obtaining appointment information from one or more supplier related to products offered and determining to what extent an entity is appointed to sell at least one or more products

However, NRS discloses obtaining appointment information (page 4 Appointments – NRS will gather the necessary information) and determine to what extent an entity is appointed to sell one or more products (page 4 an insurance license is required to sell insurance products. NRS will gather the information, prepare the required application and forms and submit the documents).

It would have been obvious to one of ordinary skill at the time of the invention to combine the appointment teaching of NRS with the employee certification and training method of Hollingsworth since a license is required to solicit, sell, negotiate or otherwise render advice relating to insurance products and every state is different when it come to the requirements of obtaining a licenses thus a compliance and consulting services would aid in this process.

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Regarding Claim 19 and 21:

Hollingsworth discloses a method comprising identifying actions required by the entity to obtain and maintain a license (col. 2, line 38- col. 3, line 6, col. 2, lines 25-40 compliance with all applicable statutes and regulations relating to training, development and licensing of personal); and

prompting (automatically notifying) the entity to take the required action (col. 2, lines 43-58, col. 3, lines 25-39 invention identifies and reports compliance).

Regarding Claim 20:

NRS discloses providing the required forms to the entity wherein the entity submits the completed forms to the licensing authority (NRS page 4 NRS will gather necessary information, complete the state specified appointment forms and submit the documents to the appropriate carrier, NRS submit the documents to the insurance department for approval) thus updating the compliance status (if not complaint before, would be complaint upon completion of the process).

Regarding Claim 21:

Hollingsworth discloses automatically prompting (page 3, lines 16-24 the present invention (a computerized system) provides full support for identifying and reporting)

Regarding Claim 22:

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Hollingsworth discloses wherein the licensing requirement information comprises examination information (Figure 3 (453), Figure 13 (Exam) and continuing education requirements (col. 3, lines 7-40 continuing training needs).

Regarding Claims 24-25:

NRS disclose the entity being an insurance agent or agency (page 3 Insurance services, page 4 compliance guides for agencies, page 5 preparation and filing licensing applications for up to four active individuals (agents))

Regarding Claim 26:

Hollingsworth discloses inputting the entity information into a database, modifying the information, retrieving the information, and viewing the information (col. 4, lines 26-67 a GUI providing a user an interface to view and update).

Regarding Claim 27:

Hollingsworth discloses obtaining continuing education provider information including curriculum information (col. 3, lines 16-24, col. 4, lines 55-57 - training program, course, lesson).

Regarding Claim 28:

Hollingsworth discloses searching the entity information database to retrieve status information pertaining to a particular entity (compliance information col. 2, lines 43-45).

Regarding Claim 30:

See the discussion of claim 21 above.

Regarding Claim 31:

NRS discloses providing materials usable by the entity to satisfy the licensing requirement (page 4 compliance guides – desktop reference guide provides organizations with an awareness of the requirements of the law, rules and regulations).

Regarding Claims 34 and 35:

Hollingsworth discloses a method for determining compliance with license requirements, comprising:

obtaining licensing requirements information from a plurality of licensing authorities via a communication network relating to obtaining and maintaining a license and storing the information in a database (Figure 3 License col. 3, lines 33-40).

organizing licensee information related to at least one licensee and organizing status information related to the status of the licensee comparing the status information with the licensing requirements and making a determination as to whether the licensee is in compliance (col. 3, lines 33-40 provides a mechanism for the identification of skills

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and licenses which an employee needs. For each employee job/task the invention identifies and reports compliance with all applicable statutes and regulations related to training, development and licensing).

Regarding Claim 36:

Hollingsworth discloses notifying the licensee of the status or change in status and upcoming licensing requirements (col. 3, lines 25-40 identifies and reports).

Response to Arguments

Applicant's arguments with respect to claims 1-4, 6-37, and 39 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are directed to the claims as amended which are now addressed in the grounds of rejection.

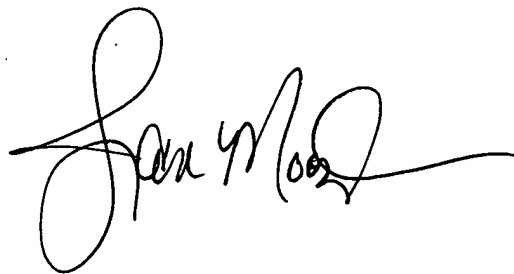
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal flourish extending to the right.

Jan Mooneyham
Patent Examiner
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